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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Menday et al.
Serial No. 10/516,532
Filed : June 13, 2005
For: *Security System*

Examiner: Joseph A. Dillon, Jr.
Group Art Unit: 3651

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the rejections in the above-identified application. No amendments are being filed with this request.

The objections raised in the Office Action were addressed in Applicants' amendment filed November 13, 2006.

This request is being filed with a notice of appeal.

The review is requested for the following remarks.

Claims 1-5, 7-9 and 31 are pending.

Rejection of claims under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-5, 7-9 and 31 "as failing to comply with the enablement requirement." See Office Action at p. 3. The Examiner indicates that this rejection is "substantially as applied on 3/29/06." See Office Action at p. 4. Applicants respectfully traverse this rejection.

In the Office Action mailed March 29, 2006, the Examiner indicated that the Examiner was "not asserting that the claim(s) are not enabled but rather that the claimed features as envisioned by the applicant have not been delineated." See Office Action mailed March 29, 2006 at p. 4. The Examiner further stated that "[w]ith regard to claim(s) 1, the applicant's preferred embodiment, i.e. the best mode, of the lock has not been disclosed." *Id.* MPEP 2165.02 states that "[t]he best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112." Further, "[t]he examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption." See MPEP 2165.03.

Applicants remind the Examiner that there is no requirement in 35 U.S.C. § 112 "that applicants point out which of their embodiments they consider to be their best; that the disclosure includes the best mode contemplated by applicants is enough to satisfy the statute." See MPEP 2165.01(III). The specification includes the best mode contemplated by the Applicants. See Fig. 2A and page 7, lines 25-28 of the specification. The Examiner has not provided a *prima facie* case that the best mode is not disclosed in the specification.

The Examiner has further rejected claims 1-5, 7-9 and 31 as failing to comply with the enablement requirement. Applicants submit that the Examiner has not met "the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." See MPEP 2164.04. "[T]he minimal requirement is for the examiner to give reasons for the uncertainty of the enablement." See MPEP 2164.04. The Examiner has not done so here. It is unclear to the Applicants why the Examiner has rejected claims 1-5, 7-9 and 31. The specification describes in detail, a carrier for transferring security documents and claimed features of the carrier throughout the specification. See for example, pages 7-14 of the specification. Applicants have informed and demonstrated to a person having ordinary skill in the art how to use the invention commensurate in scope with the claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection with respect to claims 1-5, 7-9 and 31.

CONCLUSION

In light of the foregoing remarks, Applicants respectfully contend that all conditions of patentability are met. Allowance of the claims is therefore respectfully solicited.

The Director is authorized to charge any fees required by the present Request to Deposit Account 19-4293.

Respectfully submitted,

Date: 12-13-06



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